

REMARKS ON AMENDMENTS

An amendment to the claims and the title of the pending application are presently submitted above in an effort to clarify any possible misunderstanding with the term “last.”

In the Amendment to the Claims, claims 1 and 13 are amended to clarify the meaning of a “last” of a foot. Presently, both claims 1 and 13 no longer refer to a “last” but instead to an anatomical model of a human foot. This new description is consistent with the description of a “last” in paragraph [0002] of the specification, and the definition provided in the abstract of U.S. patent 5,228,164. Reference to a “last” with regards to the forming material in both claims 1 and 13 has likewise been removed.

It will be noted that the statement of use “for producing custom footwear” is removed from the preamble of both claims 1 and 13. Since this statement of use does not limit the scope of the claims, the claims are now presented in a manner that unambiguously states that the method and kit are merely provided for preparing an anatomical model of a foot.

The amendment to the claims is not intended to limit the scope of the claims, and instead the replacement language for “last” simply comprises definitional terms commonly understood in the prior art as an equivalent to a “last.” As a result, no new subject matter has been introduced into the claims.

In the Amendment of the Specification, the title is amended to reflect the replacement language for “last” in the claims.

Entry of the amendment to the claims and the specification is respectfully requested in the next Office communication.

ELECTION

Applicants hereby elect Invention II, as identified in the restriction requirement of the Office action, for prosecution on the merits. Claims 13-21 are drawn to Invention II, and examination of such claims is respectfully requested.

Applicants hereby reserve all rights to the non-elected subject matter.

TRAVERSAL

The restriction requirement is respectfully traversed on the basis that Inventions I and II do not recite recognized divergent subject matter. More specifically, the method of claim 1 cannot be practiced by another apparatus or kit materially different from the kit prescribed by claim 13, and the kit cannot be used to practice another and materially different process from the process of claim 1.

First, the method of claim 1 requires the features of the kit of claim 13. Particularly, claim 1 recites the compliant liner element, a pliable resin carrying sock structure, and a settable forming material of the kit of claim 13. It is submitted that it would not be possible to conduct the method of claim 1 without the kit of claim 13, since the use of the features of the kit are positively recited and used in each of the steps of the method of claim 1.

Second, the kit of claim 13 cannot be used to practice another or materially different process from the method described in claim 1. In support of the restriction requirement, the examiner argues that the kit of claim 13 could be used in a materially different process such as one for creating a prosthesis foot. This argument is misplaced and the examiner fails to elaborate on how creating an anatomical model of a foot is any different from making a "last" of a foot.

There are many types of prosthetic feet, some comprise of carbon fiber springs such as Ossur Flex-Foot products (see for example <http://www.ossur.com/template110.asp?pageid=24>), others may simply comprise a foot

replica or cover that extends over a stump or other type of foot (see for example <http://www.ossur.com/template110.asp?PageID-259>). If the examiner intends to mean that a prosthetic foot replica may --be made from the kit of claim 13, then obviously there isn't any difference from a foot replica than a "last" of a foot, in which both are an anatomical foot models.

It appears that the examiner has read into the body of claim 1 the limitation that the method is solely for preparing a last "useful for producing custom footwear," while not reading such limitation into claim 13. In both claims, such limitation was only provided in the preamble as a possible intended use of either the method or kit; neither claim was limited to only such use. The term "useful" does not limit the use of the method of claim 1 no more than it limits the use of the kit of claim 13; both can be used for making anatomical models of feet for purposes other than a last for footwear. Therefore, both the method of claim 1 and the kit of claim 13 could be used to make an anatomical foot model for a prosthetic foot or a last for custom footwear.

Lastly, it is to be noted that both claims 1 and 13 originally recited "a foot for which the footwear is intended." Once again, however, the examiner appears to ignore this statement in claim 13 and not in claim 1. If it can be disregarded in claim 13 to make a prosthesis foot, how can it then be used to distinguish claim 1 as having separate status in the art from claim 13? In fact, in both claims this statement does not have a limiting effect on the claims, and instead merely identifies a foot for which a foot replica is made. This statement is presently removed from the claims to avoid any confusion.

The amendment of claims 1 and 13 make it abundantly clear that these claims are merely provided for making an anatomical model of a foot. They are not limited to a particular use of an anatomical foot model. Indeed, as both originally presented and currently amended, these claims pertain to the same subject matter, and do not have separate status in the art and recognized divergent subject matter. Thus, restriction for examination for the purposes provided in the action is improper.

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Examiner: John T. KAVANAUGH
Art Unit: 3728

As a result of this traversal, applicants hereby reserve the right of petition from the requirement for restriction.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written over a horizontal line.

Date: August 23, 2005

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